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Michael Krieger

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THE BLACK & DECKER CORPORATION
701 EAST JOPPA ROAD, TW199
TOWSON, MD 21286

EXAMINER

NEGRON, ISMAEL

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Please find below and/or attached an Office communication concerning this application or proceeding.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL KRIEGER

Appeal 2008-5380
Application 10/731,113
Technology Center 2800

Decided:¹ February 9, 2009

Before KENNETH W. HAIRSTON, JOHN A. JEFFERY,
and CARL W. WHITEHEAD, JR., *Administrative Patent Judges*.

WHITEHEAD, JR., *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant appeals under 35 U.S.C. § 134 from the Examiner's rejection of claims 14, 16-22, 25, and 27-36 (*see* App. Br. 9, Final Rej.,

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

mailed March 17, 2006). We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

STATEMENT OF THE CASE

Appellant invented a portable rechargeable electric light source with the recharging circuitry enclosed within its own separate housing. The separate housing allows the lantern to meet applicable industry standards without the need for the entire lantern housing to be rated. See generally Spec. 2-3 and 7-8.

Claims 14 and 25 are illustrative:

14. A portable rechargeable electric light comprising:
a first housing;
a rechargeable power supply disposed in said first housing;
a light source coupled to said rechargeable power supply; and
an AC-to-DC converter disposed within a second housing and being coupled to the rechargeable power supply, the AC-to-DC converter including an AC connector arranged for being connected to an external power cord for delivering AC power to the AC-to-DC converter for recharging the rechargeable power supply and the second housing being substantially enclosed by the first housing.

25. A rechargeable light source, comprising:
a first housing defining a cavity therein;
a rechargeable power supply disposed in the cavity;
a light source selectively coupled to the rechargeable power supply; and
an AC-to-DC adapter including a second housing containing converter

circuitry, the AC-to-DC adapter being arranged within the cavity such that the second housing is substantially enclosed by the first housing.

The Rejections²

The Examiner relies upon the following prior art references as evidence of unpatentability:

Werner	US 2,628,339	Feb. 10, 1953
Zeller	US 6,260,985 B1	Jul. 17, 2001
Yuen	US 6,789,924 B2	Sep. 14, 2004

1. The Examiner rejected claims 25 and 27 under 35 U.S.C. § 102(b) as being anticipated by Werner (Ans. 3-4).
2. The Examiner rejected claims 14 and 16-19 under 35 U.S.C. § 103(a) as unpatentable over Werner (Ans. 5-8).
3. The Examiner rejected claims 20-22 under 35 U.S.C. § 103(a) as unpatentable over Werner and Zeller (Ans. 8-10).
4. The Examiner rejected claims 28 and 29 under 35 U.S.C. § 103(a) as unpatentable over Werner (Ans. 10-11).
5. The Examiner rejected claims 30 and 33-36 under 35 U.S.C. § 103(a) as unpatentable over Werner and Zeller (Ans. 11-15).
6. The Examiner rejected claims 31 and 32 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Werner, Zeller and Yuen (Ans. 15-16).

² The Examiner indicates that entering an amendment after final rejection cures a deficiency that formed the basis for rejecting claim 34 under 35 U.S.C. § 112, second paragraph (Ans. 16-17). Since the Examiner has entered this amendment, we presume that the Examiner has withdrawn this rejection. Accordingly, that rejection is not before us.

Rather than repeat the arguments of Appellant or the Examiner, we refer to the Briefs and the Answer for their respective details. In this decision, we have considered only those arguments actually made by Appellant. Arguments which Appellant could have made but did not make in the Briefs have not been considered and are deemed to be waived. See 37 C.F.R. § 41.37(c)(1)(vii).

Regarding the Examiner's anticipation rejection of the representative claim 25, Appellant argues that the Werner reference fails to disclose a portable rechargeable light source wherein the housing for the converter circuitry is enclosed by the first housing (App. Br. 11). It is the Examiner's position that the scope of the claims does not support the Appellant's assertion (Ans. 15). The Examiner indicates that the language employed in claim 25 only requires that the converter circuitry be contained with a second housing and enclosing the entire AC-to-DC adapter is not required to anticipate the claim (Ans. 15).

Regarding the Examiner's obviousness rejection of representative claim 14, Appellant argues that Warner's transformer and rectifier units are not in separate housings but are mere components of the AC-to-DC converter (App. Br. 15). According to the Appellant, this configuration would not meet claim 14 because the claim requires that the rechargeable electric light includes a separate and distinct housing that encloses the entire AC-to-DC converter (App. Br. 15-16). It is the Examiner's position that both the transformer and rectifier units of Werner are each in separate housings and it would have therefore been obvious to modify Werner and incorporate them into one single housing unit (Ans. 14).

The issues before us are as follows:

ISSUES

1. Has the Appellant shown that the Examiner erred in finding that Werner anticipates the claimed invention because Werner discloses an enclosed secondary housing unit containing only converter circuitry?
2. Has the Appellant shown that the Examiner erred in finding that Werner rendered the claimed invention obvious because the transformer and rectifier was considered to be enclosed in separate housing units that would have been obvious to combine into one housing unit?

FINDINGS OF FACT

1. Figure 1 of Werner discloses a lantern with external housing consisting of transparent or translucent container (11), a charging container (75) and a cap (14). The lantern also has a rectifier unit (81) and a transformer (80) for powering light source (16).

Figure 1 of Werner

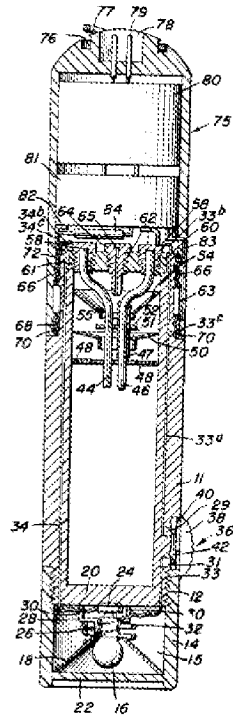


Figure 1 shows a lantern with a rectifier, transformer and light source contained with a housing composed from several other components.

2. Figure 4 of Werner discloses a section of the flashlight with a detailed view of the rectifier unit (81) and transformer (80).

Figure 4 of Werner

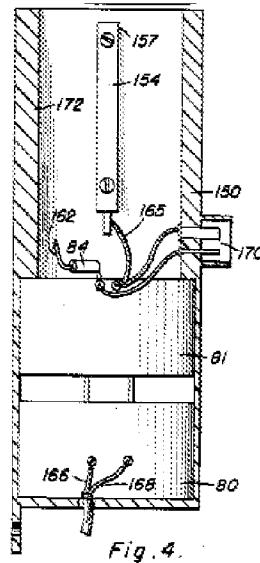


Figure 4 shows a section of the flashlight housing with a rectifier unit and a transformer unit.

3. Independent claim 14 recites “an AC-to-DC converter disposed within a second housing and being coupled to the rechargeable power supply, the AC-to-DC converter including an AC connector arranged for being connected to an external power cord for delivering AC power to the AC-to-DC converter for recharging the rechargeable power supply and the second housing being substantially enclosed by the first housing.”

4. Independent claim 25 recites “an AC-to-DC adapter including a second housing containing converter circuitry, the AC-to-DC adapter being arranged within the cavity such that the second housing is substantially enclosed by the first housing.”

PRINCIPLES OF LAW

"[T]he PTO gives claims their 'broadest reasonable interpretation.'"

In re Bigio, 381 F.3d 1320, 1324 (Fed. Cir. 2004) (quoting *In re Hyatt*, 211

F.3d 1367, 1372 (Fed. Cir. 2000)). "Moreover, limitations are not to be read into the claims from the specification." *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993) (citing *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989)).

"A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." *In re Bell*, 991 F.2d 781, 783 (Fed. Cir. 1993) (quoting *In re Rinehart*, 531 F.2d 1048, 1051 (CCPA 1976)).

If the Examiner's burden is met establishing the prima facie case, the burden then shifts to the Appellant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. *See In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

ANALYSIS

*35 U.S.C. § 102 (b) rejection (claims 25 and 27)*³

Appellant recognizes that Werner discloses a flashlight with a rectifier unit (81) for converting alternating current into direct current (App. Br. 11). The Appellant's contention is that Werner fails to disclose a "second housing containing converter circuitry" that is "substantially enclosed by the first housing" (App. Br. 11). This assertion by the Appellant in itself is not persuasive. It is evident from Figures 1 and 4 of Werner that both the rectifier and the transformer units are in separate housing that are enclosed

³ Appellant argues claims 25 and 27 together (App. Br. 10 – 14).

by the housing of the flashlight (FF 1, FF 2). Appellant does not provide any evidence to the contrary.

Appellant states, “The AC-to-DC adapter 144, as recited in claim 25, is the entirety of the AC-to-DC converter circuitry being contained within a second housing” (App. Br. 11: lines 30-32). This position is not commensurate with the scope of claim 25 (FF 4). Claim 25 does not require the entire AC-to-DC adapter to be contained within a second housing (FF 4). Claim 25 only requires that the second housing contain converter circuitry (FF 4). The rectifier (81) of Werner is packaged as a discrete component (FF 1, FF 2). A rectifier converts alternating current to direct current. Therefore the rectifier of Werner meets the claim limitation set forth in claim 25.

Appellant relies upon *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) to support the assertion that the Examiner should have interpreted the second housing limitation in claim 25 in the manner in which the housing was described in the Specification (App. Br. 13). As stated previously, the Appellant’s position is not commensurate with the scope of claim 25 (FF 4). The Specification is silent in regards to the location of the converter circuitry, but states “[t]he first housing encloses the adapter circuitry and may be, for example, the housing of a wall cube” (Spec. 7:26-28). No correlation has been established between the composition of the adapter circuitry specified in the Specification and the composition of the converter circuitry specified in claim 25. Thus, we consider the Examiner’s interpretation to be reasonable based upon the record before us.

For the foregoing reasons, the Examiner did not err in finding that Werner anticipates the invention recited in claim 25. Accordingly, we will

sustain the Examiner's anticipation rejection of claim 25, and claim 27 which was not separately argued.

35 U.S.C. § 103 (a) rejections (claims 14 and 16-19)⁴

Appellant states that “Werner’s transformer 80 and rectifier unit 81 do not constitute separate housings, but are mere components of the AC-to-DC converter” (App. Br. 15). This argument is not found to be persuasive. The rectifier and the transformer are discrete components working in conjunction with each other while being separately housed (FF 1, FF 2). Appellant also contends that the claimed invention “includes a second housing, separate and distinct from any of the AC-to-DC converter components, that is used to enclose the AC-to-DC converter and all the components therein” (App. Br. 15: lines 31-32 and 16: line 1). This assertion is not commensurate with the scope of claim 14 (FF 3). Further, the Specification (Spec. 7-8) does not support the Appellant’s assertion that the housing is “separate and distinct from any of the AC-to-DC converter components” (App. Br. 15, line 32 and 16, line 1). The section of the Specification that refers to the housing configuration does not refer to the employment of an AC-to-DC converter at all (Spec. 7-8).

Though understanding the claim language may be aided by the explanations contained in the written description, it is important not to import into a claim limitations that are not a part of the claim. For example, a particular

⁴ Although Appellant argues claims 14, 16, and 17 together (App. Br. 14-16), Appellant nonetheless argues claim 17 separately (App. Br. 16). Accordingly, we treat claim 17 separately from claims 14 and 16. Also, since Appellant argues claims 18 and 19 separately, we likewise treat those claims separately.

embodiment appearing in the written description may not be read into a claim when the claim language is broader than the embodiment. *Electro Med. Sys. S.A. v. Cooper Life Sci., Inc.*, 34 F.3d 1048, 1054 (Fed. Cir. 1994).

See Superguide Corp. v. DirecTV Enterprises, Inc., 358 F.3d 870, 875 (Fed. Cir. 2004).

Appellant argues that Werner fails to provide motivation for combining elements 80 and 81 into a single housing (App. Br. 16). The motivation for combining two separately housed elements into one housing with both elements does not have to originate from Werner.

When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense.

See KSR Int'l v. Teleflex, Inc., 127 S. Ct. 1727, 1742 (2007).

In other words, it is well within the skill of the artisan to recognize that the two elements can be housed in only two ways, either together or separately.

Thus, for the foregoing reasons, Appellant has not persuaded us of error in the Examiner's obviousness rejection of claim 14 over Werner.

Appellant argues that Werner does not disclose an AC-to-DC converter circuit and prongs that comprise a wall cube as required by claim 17 (App. Br. 16). The Examiner responds that Werner discloses a wall cube, and directs the Appellant to elements 78 and 79 of Figure 1 and 79a-b of Figure 2 (Ans. 23). Claim 17 claims a non-descript wall cube (App. Br. 21).

We find no error in the Examiner's position that Werner discloses a wall cube as stated in claim 17. Accordingly, we will sustain the Examiner's obviousness rejection of claim 17, and claim 16 which was not separately argued.

35 U.S.C. § 103 (a) rejections (claims 18, 19, 28 and 29)⁵

The Appellant argues that even if Werner does disclose every element of claims 18 and 19, with the exception of the second housing meeting UL standards, neither Werner nor the other prior art references provide motivation to modify the housing to meet the UL standards (App. Br. 17-18). As we stated earlier in this decision, the motivation does not have to originate from the references only. *See KSR*, 127 S. Ct. at 1742. Further, standards are subject to change as the technology advances, and the artisan is presumed to possess the skill to appreciate that the second housing must meet applicable UL and other standards. Accordingly, we will sustain the Examiner's obviousness rejections of claims 18, 19, 28 and 29.

35 U.S.C. § 103 (a) rejections (claims 20-22 and 30-36)

Appellant states that claims 20-22 are dependent, directly or indirectly, on independent claim 14 (App. Br. 18). Appellant further states that claims 30-36 are dependent, directly or indirectly, on independent claim 25 (App. Br. 19). It is the Appellant's position that since Werner fails to disclose the limitations of claims 14 and 25, that Werner in combination with Zeller and Yuen likewise fail to establish a prima facie case of

⁵ We will treat claims 18, 19, 28 and 29 together since they contain similar subject matter (App. Br. 14-18).

obviousness under 35 U.S.C. § 103(a) (App. Br. 18-19). We have already indicated that Werner discloses the claim limitations of claims 14 and 25 earlier in this decision. The Appellant has not set forth any arguments other than the dependency of the claims and, therefore, Appellant has failed to particularly point out errors to persuasively rebut the Examiner's prima facie case of obviousness based on the collective teachings of the cited references. Accordingly, we will sustain the Examiner's obviousness rejections of claims 20-22 and 30-36.

CONCLUSIONS OF LAW

The Appellant has not shown that the Examiner erred in finding that Werner anticipates the limitations of claims 25 and 27. The Appellant has also not shown that the Examiner erred in finding that Werner alone and/or in combination with Zeller and Yuen in rejecting claims 14, 16-22, and 28 to 36 respectfully under § 103.

DECISION

The Examiner's decision rejecting claims 14, 16-22, 25, and 27-36 is affirmed.

Appeal 2008-5380
Application 10/731,113

No time for taking any action connected with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

KIS

THE BLACK & DECKER CORPORATION
701 EAST JOPPA ROAD, TW199
TOWSON MD 21286